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In re Application of
Naicker et al.

Application No.: 10/579,806

DECISION

PCT No.: PCT/IB04/04060

ON

Int. Filing Date: 10 December 2004

Priority Date: 10 December 2003

PETITION

Attorney Docket No.: 06-361

For: System For Playing A Bingo-Type Game

This is in response to the petition under 37 CFR 1.47(a) filed on 07 August 2007.

BACKGROUND

This international application was filed on 10 December 2004, claimed an earlier priority date of 10 December 2003, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 23 June 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 10 June 2006. Applicants filed *inter alia* the basic national fee on 16 May 2006.

On 10 January 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b).

DISCUSSION

Petitioner alleges that joint inventor Devan Govender has refused to execute the application. A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding **requirement (1)**, petitioner has paid the \$200.00 petition fee.

Regarding **requirement (2)**, counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an

application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The evidence presented tends to suggest that Mr. Govender may have refused to execute a declaration document after having been presented with the declaration and a copy of the application. However, while the various email communications appear to have been carried out by Ms. Tracey Clarke, petitioner has not provided a statement from her introducing the email evidence and attesting to the facts surrounding those communications, especially Exhibit G.

Regarding requirement (3), the petition includes a statement of two last known addresses for Devan Govender. However, it appears that one of the addresses may be his permanent address and the other a temporary or holiday address. Insofar that the last-known address is used for purposes of providing notice of the filing to the non-signing inventor upon the grant of status under 37 CFR 1.47(a), a temporary address is inappropriate. Petitioner should clarify which address is in fact Mr. Govender's last-known permanent address.

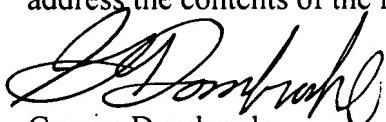
Regarding requirement (4), the declaration of inventorship filed on 07 August 2007 is acceptable for purposes of compliance with 37 CFR 1.497(a) and (b). Requirement (4) thereby has been satisfied.

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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